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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,161	09/10/2001	Tsunetoshi Honma	067242-0152	9225

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FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/936,161

**Applicant(s)**

HONMA ET AL.

**Examiner**

Brenda Coleman

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8,11-14 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8,11-14 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 8, 11-14 and 19-22 are pending in the application.

This action is in response to applicant's amendment filed May 3, 2004. Claim 19 was amended and claims 20-22 are newly added.

### *Response to Amendment*

Applicant's arguments filed May 3, 2004 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejection labeled 2c) of the last office action, which is hereby **withdrawn**.
2. With regards to the obviousness-type double patenting rejection as being unpatentable over U.S. Patent No. 6,384,075 and U.S. Patent No. 6,172,113 of the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive. The applicant's stated that U.S. Patent Nos. 6,384,075 and 6,172,113 were assigned to the same assignee as for the present application and, therefore, qualify for the safe harbor provision of 35 USC § 103(c). However, the applicants' arguments are not on point. It is not a question of obviousness under 35 U.S.C. § 103 but rather the applicants' extension of monopoly or litigation between more than one party when the rights of more than one patent is being enforced. Thus as stated in the last office action claims 8, 11-15 and 19 are rejected under the judicially created doctrine of **obviousness-type double patenting** as being unpatentable over claims 1-5 and 7-11 of U.S. Patent No. 6,384,075 and claims 15 and 19 are rejected

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under the judicially created doctrine of **obviousness-type double patenting** as being unpatentable over claims 1, 5 and 6 of U.S. Patent No. 6,172,113.

Claims 8, 11-14, 19 and newly added claims 20-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 7-11 of U.S. Patent No. 6,384,075, for reasons of record and stated above.

Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5 and 6 of U.S. Patent No. 6,172,113, for reasons of record and stated above.

3. With regards to the provisional obviousness-type double patenting rejection as being unpatentable over copending Application No. 10/297,065 of the last office action, the applicant's remarks have been fully considered but they are not persuasive. The applicant's stated that when the only rejection remaining is a provisional double patenting rejection, the Examiner should withdraw the rejection and allow the application to issue as a patent. However, this is not the only issue remaining.

Claims 8, 11-14, 19 and newly added claims 20-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 8-22 of copending Application No. 10/297,065, for reasons of record and stated above.

4. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejection labeled 8a) of the last office action, which is hereby **withdrawn**.

5. With regards to the 35 U.S.C. § 103, obviousness rejection of claims 8, 11-15 and 19 as being obvious over WO 97/00853 (U.S. equivalents 6,384,075 and 6,172,113) of the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive. The applicant's stated that the generic teachings of this patent would not motivate one of ordinary skill in the art to arrive at the present invention rather than over the large number of other possible variations disclosed in WO 97/00853A. However, as shown by claim 13 which states:

Claim 13. The compound of claim 11, its salt or hydrate thereof, wherein **X<sub>1</sub>** is phenylene or **thiophenediyl**, **X<sub>2</sub>** is a single bond, **-N=N-**, **-CH=CH-**, ethynylene, **-O-**, **-S-**, **-CO-**, **-CON(R<sub>55</sub>)-** (**R<sub>55</sub> is as defined above**), **-N(R<sub>51</sub>)CO-** (**R<sub>51</sub> is as defined above**) and **X<sub>3</sub>** is phenyl or **thienyl**.

specifically defines the variables defined herein. The specification of U.S. 6,384,075, which is an English version of WO 97/00853 teaches a preferred embodiment of formula (Ib) where **X<sub>1</sub>** is phenylene, **thiophenediyl**, **indolediyl** or **oxazolediyl**, **X<sub>2</sub>** is a single bond, **-N=N-**, **-CH=CH-**, ethynylene, **-S-** or **-O-**, and **X<sub>3</sub>** is aryl or **heterocyclic group** (at lines 43-46 in column 5).

Claims 8, 11-15, 19 and newly added claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani et al., WO 97/00853, for reasons of record and stated above.

In view of the amendment dated May 3, 2004, the following new grounds of rejection apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 8, 11-14 and 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by a "compound of the formula (I)", however, there is no formula (I) within the claim.
- b) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the definition of variables Y, R<sup>1</sup>, m, X<sup>1</sup>, X<sup>3</sup> and X<sup>2</sup> since there are variables in the claim.
- c) Claim 21 recites the limitation "-SO<sub>2</sub>-, -S-, CH<sub>2</sub>-, CH<sub>2</sub>-S-, or -S-CH<sub>2</sub>-" in the definition of X<sup>3</sup>. There is insufficient antecedent basis for this limitation in the claim.
- d) Claim 21 is vague and indefinite in that it is not known what is meant by the definition of X<sup>3</sup>, which includes two moieties that are not stated as divalent, i.e. CH<sub>2</sub>-, CH<sub>2</sub>-S-.
- e) Claim 22 recites the limitation "-S-CH<sub>2</sub>-X<sup>3</sup>" in the definition of X<sup>2</sup>. There is insufficient antecedent basis for this limitation in the claim.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman  
Primary Examiner Art Unit 1624  
July 19, 2004